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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

522208-0000024

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on _____

Signature _____

Typed or printed name _____

Application Number

10/510,124

Filed

October 4, 2004

First Named Inventor

DAHLBERG, Anders

Art Unit

3724

Examiner

Dexter, Clark F.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

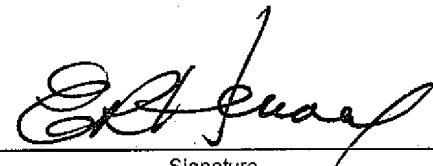
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 47,641

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

E. Rico Hernandez

Typed or printed name

703.770.7788

Telephone number

August 19, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 522208-0000024
Client Reference: HPX0088-PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: Confirmation Number: 6608

DAHLBERG

Application No.: 10/510,124

Group Art Unit: 3724

Filed: October 4, 2004

Examiner: C. DEXTER

Title: TOOL DEVICE FOR HIGH-SPEED MACHINE-WORKING

COMMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that a panel of Examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an Appeal Brief. Appellant asserts that the outstanding rejections (now on appeal by virtue of the concurrently filed Notice of Appeal) are clearly improper based upon errors in facts and the omission of essential elements required to establish *prima facie* rejections (e.g., the cited references fail to disclose all of the recited claim features).

APPEALED REJECTIONS

Appellant is hereby appealing the rejections in the Final Office Action of May 19, 2009 (hereinafter "Final Action") of claims 18, 19, and 21 which stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,470,330 to Lindell (hereinafter "Lindell"); claims 13-17 and 20 which stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable by Lindell in view of U.S. Patent 3,391,591 to Funke (hereinafter "Funke") and U.S. Patent 1,318,249 to Winters (hereinafter "Winters").

ARGUMENTS FOR TRAVERSAL:

- A. **Claims 18, 19, and 21 are patentable over Lindell**
- B. **Claims 13-17 and 20 are patentable over Lindell in view of Funke and Winters**

I. Summary of Claimed Invention

Appellant submits that the cited portions of Lindell fail to disclose, teach, or suggest a tool device for high-speed crosscutting, comprising, *inter alia*, said tool housing comprising a solid base element with a horizontally extending circular recess for receiving said fixed crosscutting tool; said recess having a supporting surface with support material for withstanding impact acting in a transverse direction on said fixed crosscutting tool, the supporting surface being curved and having a radius; and wherein, in the direction of impact, a vertical material thickness of said solid base element measured from said supporting surface to an upper end surface of said base element is greater than a transverse material thickness of said base element, and wherein said fixed crosscutting tool has curved edge surfaces that are fitted into said recess of said base element, said curved edge surfaces having a substantially similar radius as said recess to assist in alignment of said tool device, as recited in independent claim 18. Similarly, Appellant also submits that the cited portions of Lindell, Funke, Winters, and any combination thereof fail to disclose, teach, or suggest a tool device for high-speed crosscutting a workpiece, comprising, *inter alia*, the tool housing has at least two supporting surfaces for positioning said movable crosscutting tool, said supporting surfaces being curved and having a same radius, wherein a piston access recess is constructed and arranged between said curved supporting surfaces to provide space for movement of said striking piston therein, and wherein said movable crosscutting tool has curved edge surfaces in contact with said curved supporting surfaces of said tool housing, said curved edge surfaces having a substantially similar radius as said curved supporting surfaces to assist in alignment of said tool device, as recited in independent claim 13.¹

II. Lindell does not anticipate a tool device as claimed

Appellant submits that the cited portions of Lindell fail to disclose, teach, or suggest at least “wherein, in the direction of impact, a vertical material thickness of said solid base element

¹ Appellant notes that the underlined portions of the claims indicate the amendments submitted in an After Final Amendment dated August 18, 2009. Because the amended claims do not add new subject matter, are submitted for clarification purposes only based on the Examiner’s suggestion, and present the claims in better form for consideration on appeal (in accordance with 37 C.F.R. §1.116), Appellant is using the amended claims based on the fact that they should be admitted as a matter of right.

measured from said supporting surface to an upper end surface of said base element is greater than a transverse material thickness of said base element,” and “said fixed crosscutting tool has curved edge surfaces that are fitted into said recess of said base element, said curved edge surfaces having a substantially similar radius as said recess to assist in alignment of said tool device,” as recited in claim 18. The Examiner asserts that in elements 27, 36, 53, and 57, illustrated in Figure 2 of Lindell, allegedly shows such features. See Final Action, page 4. However, nowhere in Lindell are the thicknesses of a solid base element disclosed, nor is it taught to provide solid base element with thicknesses as recited in claim 18. “When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”). See MPEP §2125. Appellant also submits that the specification of Lindell also fails to provide any dimensions with regard to its tooling assembly, and, therefore, does not and could not suggest at least these recited features.

Additionally, the Examiner has still failed to show or provide any recitation in Lindell that allegedly anticipates a “fixed crosscutting tool [that] has curved edge surfaces that are fitted into said recess of said base element, said curved edge surfaces having a substantially similar radius as said recess to assist in alignment of said tool device,” as recited in claim 18. See Final Action at pages 4-5. As acknowledged by the Examiner, the “features lacking in Lindell are corresponding radiussed concave corners formed by the support surface....of the opening that accommodates tool 26.” See Final Action, page 10. However, the Examiner alleges that providing radiussed corners is old and well known in the art, and therefore it would have been obvious to replace the square concave corners of the assembly of Lindell with radiussed ones.² See Final Action, page 10 and Lindell, Figures 3 and 5. Appellant submits that providing such features would not have been obvious because Lindell fails to provide any motivation to do so, and providing curved and radiussed surfaces as recited in claim 18 would require one to

² The Examiner’s comment regarding Funke on pages 10-11 were not considered with regard to claim 18, as it is the Appellant’s understanding that Funke is not used in the rejection of claim 18.

manufacture and substantially modify the design and faces of each of the tool elements surrounding the die block 27 (e.g., clamping blocks 33, guide block means 34, cap blocks 35 and 36, and transfer block 53).

III. Neither of Funke nor Winters overcomes the deficiencies of Lindell

As acknowledged by the Examiner, the cited portions of Lindell lack at least “said supporting surfaces being curved and having a same radius” and a “movable crosscutting tool has curved edge surfaces in contact with said curved supporting surfaces of said tool housing...,” as recited in claim 13. *See* Final Action, page 7. The Examiner therefore relies on tool 23 of Funke. However, Appellant notes that, at most, the cited portions of Funke disclose a knife plate 23a used to assist in guiding the insertion of rods in stationary plate 2 and into a rod shearing device 23. Funke does not, in any way, disclose or suggest a movable crosscutting tool with curved edge surfaces in contact with curved supporting surfaces of a tool housing as recited in claim 13.

Also, the Examiner alleges that Figure 3 shows a “recess” between the surfaces of 32 through which 30 extends that is equivalent to the recess recited in claim 13. *See* Final action, page 6. The Examiner further alleges that the piston access recess of claim 13 “defines the location and the size to accommodate and intended use,” and that there is no recitation that positively recites that the piston extends into this recess. *See* Final Action, page 11. Appellant respectfully disagrees with the Examiner’s analysis. Claim 13 recites “a piston access recess is constructed and arranged between said curved supporting surfaces to provide space for movement of said striking piston therein,” and that said curved supporting surfaces are a part of the tool housing “for positioning said movable crosscutting tool.” That is, the curved supporting surfaces, which support the movable crosscutting tool, have a piston access recess therebetween for a striking piston. At most, Lindell shows that base plate 32 is clamped with impact block 30. *See* Lindell, Figure 3. Base plate 32 does not have a piston access recess. Thus, none of the surfaces between 30 and 32 would “provide space for movement of said striking piston therein.” The Examiner’s allegation that the ram 20 can “at least partially entering the space/recess in feature 32” is incorrect and technically not feasible. *See* Final Action at page 11. Specifically, the ram 20 of Lindell is designed to impact block 30. *See, e.g.,* Lindell at column 2, lines 40-54 and column 4, lines 21-24, and Figures 2 and 3. Thus, ram 20 can not move into the space or

recess between the surfaces of 32 through which block 30 extends. *At most*, the space in frame 16 may receive a part of the ram 20 when impacting block 30. However, Appellant submits that the space in frame 16 does not provide a piston access recess between curved supporting surfaces as recited in claim 13. Specifically, the space in frame 16 does not provide at least two supporting surfaces for positioning a movable crosscutting tool. Thus, the combination of Lindell and Funke fails to disclose or suggest the features recited in claim 13.

With respect to claim 14, the Examiner alleges that such cylindrical surfaces for fixed tools are old and well known in the art. *See* Final Action, page 8. Winters is recited as allegedly disclosing an example of "a cylindrical configuration for fixed tools." Appellant respectfully disagrees and submits that there is no motivation to combine the cited portions of Lindell and Winters. Again, the tool housing 25 of Lindell has an area which is not of curved shape (acknowledged by the Examiner on page 10 of the Final Action). *See* Lindell at Figure 5. In order to provide the surrounding parts of tool housing 25 of Lindell with surfaces as shown in Winters, as one would need to manufacture and substantially manipulate the design and faces of each of the tool elements surrounding the die block 27. *See, e.g.,* Lindell at Figures 2 and 3 and column 3, lines 50-53. Thus, Appellant submits that it would not be obvious nor is there motivation to manipulate the tooling assembly of Lindell.

CONCLUSION

In view of the foregoing, Appellant respectfully requests that the panel return a decision concurring with Appellant's position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appeal rejections. Specifically, the subject matter in claims 13-21 is not anticipated and non-obvious over Lindell, Funke, Winters, and a combination thereof.

Respectfully submitted,
PILLSBURY WINTHROP SHAW PITTMAN LLP



E.R. HERNANDEZ
Reg. No. 47,641
Tel No. 703.770.7788

August 19, 2009
ERH/JAS
P.O. Box 10500
McLean, VA 22102
(703) 770-7900